

PATENT

Atty Docket No.: 200403364-1

App. Ser. No.: 10/830,218

REMARKS

Favorable reconsideration of this application is respectfully requested in view of amendments above and the following remarks. Claims 1-27 are pending in the present application of which claims 1, 15, 20, 24 and 27 are independent.

Claims 3-8, 23, and 26 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-7, 9-10, 13-17, and 19-27 were rejected under 35 U.S.C. §103(a) as being unpatentable over Ranganathan et al. (2003/0156074) in view of Nakamura (2003/0043137).

Claims 8 and 18 were rejected under 35 U.S.C. §103(a) as being unpatentable over Ranganathan et al. (2003/0156074) in view of Nakamura (2003/0043137).

Claims 11 and 12 were rejected under 35 U.S.C. §103(a) as being unpatentable over Ranganathan et al. (2003/0156074) in view of Nakamura (2003/0043137) in further view of Schleicher et al. (2002/0138744).

These rejections are traversed for the reasons stated above.

Drawings

The indication that the Drawings submitted on April 23, 2004 have been approved is noted with appreciation.

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Claim Rejection Under 35 U.S.C. §112

Claims 3-8, 23 and 26 were rejected under 35 USC §112 second paragraph as being indefinite. In particular claims 3 and 26 were cited as being indefinite because it is allegedly unclear which claimed metrics the term "some" is referring to in line 4 of each of the claims.

Claim 3 recites, "the plurality of metrics including at least some of a usage metric, a power consumption metric, a lifetime metric, and the cost metric." Claim 26 has a similar recitation. The Applicant believes it is clear that "some" refers to all the metrics that directly follow, namely, a usage metric, a power consumption metric, a lifetime metric, and the cost metric.

Claim 23 was rejected because of a lack of antecedent basis for "the plurality of metrics." Claim 23 has been amended to be dependent on claim 22, which recites a plurality of metrics. Claim 26 has been amended to be dependent on claim 25 to provide antecedent basis for "each of the configurations." Thus, claims 3-8, 23 and 26 are believed to be definite, and the rejection under 35 USC §112 second paragraph should be withdrawn.

Claim Rejections Under 35 U.S.C. §103(a)

The test for determining if a claim is rendered obvious by one or more references for purposes of a rejection under 35 U.S.C. § 103 is set forth in *KSR International Co. v. Teleflex Inc.*, 550 U.S., 82 USPQ2d 1385 (2007):

"Under §103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought

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to be patented.” Quoting *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1 (1966).

According to the Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in view of *KSR International Co. v. Teleflex Inc.*, Federal Register, Vol. 72, No. 195, 57526, 57529 (October 10, 2007), once the *Graham* factual inquiries are resolved, there must be a determination of whether the claimed invention would have been obvious to one of ordinary skill in the art based on any one of the following proper rationales:

(A) Combining prior art elements according to known methods to yield predictable results; (B) Simple substitution of one known element for another to obtain predictable results; (C) Use of known technique to improve similar devices (methods, or products) in the same way; (D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results; (E) “Obvious to try”—choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success; (F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art; (G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention. *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, 82 USPQ2d 1385 (2007).

Furthermore, as set forth in *KSR International Co. v. Teleflex Inc.*, quoting from *In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006), “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasonings with some rational underpinning to support the legal conclusion of obviousness.”

Furthermore, as set forth in MPEP 2143.03, to ascertain the differences between the prior art and the claims at issue, “[a]ll claim limitations must be considered” because “all words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385.

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If the above-identified criteria and rationales are not met, then the cited references fail to render obvious the claimed invention and, thus, the claimed invention is distinguishable over the cited references.

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Claims 11-12 were rejected under 35 U.S.C. §103(a) as being unpatentable over Ranganathan et al. (2003/0156074) in view of Nakamura (2003/0043137) in further view of Schleicher et al. (2002/0138744).

These rejections must all be withdrawn because Ranganathan et al. (2003/0156074) does not qualify as prior art against the claimed invention under 35 USC 103. Section 35 USC 103 (c)(1) states the following:

35 USC 103 (c)

(1) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Ranganathan et al. (2003/0156074) qualifies as prior art only under 35 USC 102(e). Also, Ranganathan et al. (2003/0156074) was assigned to the assignee of the present invention on October 1, 2002, which is prior to the filing of the present application. See assignment recorded in USPTO at reel/frame 018606/0544. Accordingly, the subject matter

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and the claimed invention were owned by the same person or subject to an object of an assignment to the same person at the time the claimed invention was made. Hence, Ranganathan et al. (2003/0156074) cannot be used to preclude patentability of the claimed invention under 35 USC 103, and all the rejection under 35 USC 103 must be withdrawn.

Furthermore, the Official Notice taken with respect to the rejection of claims 8 and 18 is traversed because ranking different options based on a weighting algorithm giving weights to metrics for controlling a display is not believed to be well known at the time of the invention. If the rejection is maintained, the Examiner must provide a reference teaching the claimed features. The Office Action, under "Response to Arguments" states that the Applicant must specifically point out the supposed errors in the Examiner's reasoning in order to properly traverse the official notice. However, the Examiner has failed to provide any reasoning as to why these features are considered well known and also fails to provide any evidence that these features are well known. The Examiner simply provides a conclusory statement that these features are well known without any reasoning. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness based on official notice.

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Conclusion

In light of the foregoing, withdrawal of the rejections of record and allowance of this application are earnestly solicited.

Should the Examiner believe that a telephone conference with the undersigned would assist in resolving any issues pertaining to the allowability of the above-identified application, please contact the undersigned at the telephone number listed below. Please grant any required extensions of time and charge any fees due in connection with this request to deposit account no. 08-2025.

Respectfully submitted,

Dated: September 2, 2008

By



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